

THIS DISPOSITION IS NOT
CITABLE AS PRECEDENT OF THE TTAB APRIL 11, 00

U.S. DEPARTMENT OF COMMERCE
PATENT AND TRADEMARK OFFICE

Trademark Trial and Appeal Board

In re Bently Nevada Corporation

Serial No. 75/106,184

Bernhard Kreten for Bently Nevada Corporation

Stanley I. Osborne, Jr., Trademark Examining Attorney, Law
Office 102 (Thomas Shaw, Managing Attorney)

Before Cissel, Seeherman and Walters, Administrative
Trademark Judges.

Opinion by Seeherman, Administrative Trademark Judge:

Bently Nevada Corporation has appealed from the
refusal of the Trademark Examining Attorney to register
MACHINE MANAGER as a trademark for "computer software,
namely, a diagnostic software tool to monitor the status of
rotating shafts primarily for use in power plants and

petro-chemical processing plants."¹ Registration has been refused pursuant to Section 2(e)(1) of the Trademark Act, 15 U.S.C. 1052(e)(1), on the ground that applicant's mark is merely descriptive of its identified goods.

The case has been fully briefed; an oral hearing was not requested.

We reverse the refusal of registration.

Preliminarily, we note that with his appeal brief the Examining Attorney has submitted a substantial amount of evidence which had not previously been made of record. Because applicant has not objected to the late-filed third-party registrations, NEXIS excerpts and dictionary definitions,² and has discussed them in its reply brief, thereby in effect stipulating to its inclusion, we have considered this material.³ However, we must express our

¹ Application Serial No. 75/106,184, filed May 17, 1996, asserting a bona fide intention to use the mark in (cont'd.) commerce. Although applicant indicates in its brief that its mark has been used in commerce since 1996, an amendment to allege use has not been filed. Moreover, although in its briefs applicant has referred to its registrations for other "Manager" marks, and stated that because of its ongoing use consumers recognize its "Manager" marks as identifying applicant's goods, we do not regard these references as an assertion that its present mark should be registered under the provisions of Section 2(f). In any event, such a Section 2(f) claim, raised for the first time in its briefs, would be untimely.

² The Board may, in any event, take judicial notice of dictionary definitions. **University of Notre Dame du Lac v. J. C. Gourmet Food Imports Co., Inc.**, 213 USPQ 594 (TTAB 1982), aff'd, 703 F.2d 1372, 217 USPQ 505 (Fed. Cir. 1983).

³ Applicant did not discuss the web site material, so we have not treated it as of record.

disapproval of the Examining Attorney's actions in waiting until the filing of his brief to submit this evidence. We are particularly disturbed by his actions since he had an opportunity to file this evidence as part of his response to applicant's request for reconsideration, which had been filed with applicant's notice of appeal, and, in fact, the decision on the request for reconsideration was issued after applicant had filed its appeal brief. Despite this, the Examining Attorney's action on the request for reconsideration was merely a reiteration, using the identical words, of the final Office action.

The test for determining whether a mark is merely descriptive is whether the involved term immediately conveys information concerning a quality, characteristic, function, ingredient, attribute or feature of the product or service. **In re Venture Lending Associates**, 226 USPQ 285, 286 (TTAB 1985).

Applicant has explained that its diagnostic software

is used to monitor the status of rotating equipment, such as shaft deflection. In other words, Appellant's software monitors changes in the deflection of a shaft and this information may be retrieved by the engineer responsible for maintenance. If the change monitored by the engineer is a change which is unwanted, some action is taken on the engineer's part to correct the anomaly. Thus, the

Ser. No. 75/106,184

software does not "manage" any
machinery, but rather monitors changes

which occur in rotating shafts in large pieces of industrial equipment.

Brief, p. 4.

The Examining Attorney asserts that MACHINE MANAGER is merely descriptive because it describes a function of applicant's goods, namely, that the software manages, i.e., monitors, reports and directs the operation of, machines in power plants and petro-chemical processing plants. In particular, the Examining Attorney contends that the term "manager" is commonly used in the computer industry to identify computer software that performs certain management, monitoring, or housekeeping tasks or functions related to the operation of systems, and that, as used in the mark, MANAGER immediately conveys to purchasers the information that the product possesses attributes that directly relate to monitoring and managing the machines.

In support of his position the Examining Attorney has submitted various definitions for "manage," "manager," "machines," "monitor" and "housekeeping," some of which are listed below:

Manager: In general, any program that is designed to perform a certain set of "housekeeping" tasks related to computer operation—for example, the maintenance of files.

On the Apple Macintosh, *Manager* (with a capital M) is used in the names of

various separate portions of the computer's operating system that handle input, output, and internal functions. Among these are File Manager, Font Manager, AppleTalk Manager, Memory Manager, Window Manager, Menu Manager, and so on. For example, the File Manager handles requests to open and close files, keeps a list of the names of mounted disks, and so on; the Font Manager keeps a list of the available fonts and returns information about the available font sizes loaded in the System File, among other things; and the AppleTalk Manager arbitrates input and output over the AppleTalk network.⁴

Machine: a simple device, such as a lever, a pulley, or an inclined plane, that alters the magnitude or direction, or both, of an applied force; a simple machine.⁵

As used in connection with software, the definition of "manager" indicates that it refers to the operating system of the computer. This definition does not show that software which is used to monitor or track the status of equipment such as rotating shafts would be referred to, or described, by the term "manager." Further, the Examining Attorney's reliance on the definitions of "monitor" ("a program that observes, supervises, or controls the activities of other programs")⁶ and "housekeeping" ("routine

⁴ Microsoft Press Computer Dictionary, 2d ed. © 1994.

⁵ The American Heritage Dictionary of the English Language, 3d ed. © 1992.

⁶ The Computer Glossary, 7th ed. © 1995. The Examining Attorney did not submit a copy of this definition but, as noted (cont'd.)

tasks and procedures carried out in the functioning of an operation or system")⁷ tend to show the suggestiveness, rather than the descriptiveness, of MACHINE MANAGER. That is, if a consumer must first consider the definition of "monitor" or "housekeeping" and then determine the connection between those terms and "manager," the consumer must obviously undertake the multi-stage reasoning process that is the hallmark of a suggestive mark. See **In re Gyulay**, 820 F.2d 1216, 3 USPQ2d 10009 (Fed. Cir. 1987).

The Examining Attorney has also submitted the results of searches of the NEXIS data base for stories containing the words "manager" and "software," and "machine" and "manager," in proximity to each other. We agree with applicant that the references retrieved by the searches are either irrelevant to, or not probative of, the issue before us. For example, some of the excerpts submitted by the Examining Attorney merely contain the word "machine" in one sentence, and the word "manager" in the following sentence:

"Although you might question the possibility of such a virus, many "newbies" will simply be terrified by the prospect of infecting their machines.
IS managers must be prepared to deal with the Good Times virus hoax and

previously, the Board may take judicial notice of dictionary definitions.

⁷ The American Heritage Dictionary of the English Language, 3d ed. © 1992.

other similar ones by reassuring users as necessary.

"Infoworld," July 1, 1996

It is clear from other excerpts that the word "manager" refers to a human being, rather than computer software:

Through a graphic interface on the computer screen that actually shows what is going on inside the vending machine, the manager can "visit" a vending machine from the comfort of the home office by simply pointing and clicking the computer mouse.

"Beverage World," October 1996

Sophisticated cutting machines reduce tool wear by performing crash analyses before cutting starts. Very little pressure is needed for cutting, and the tools "land" softly on the surface, reducing tool replacement. The operating hours of each of the tools can be obtained from the control computer screen, enabling the machine manager to replace worn tools before they can cause any damage to the glass.

"Ceramic Industry," June 1, 1999

Other excerpts use the term Machine Manager in a trademark manner, i.e., "Virtual Machine Manager."

In short, none of the NEXIS evidence proves that MACHINE MANAGER, as used in connection with applicant's identified goods, is merely descriptive.

The third-party registrations submitted by the Examining Attorney show that various marks containing the word MANAGER were registered on the Supplemental Register,

thereby indicating their descriptive nature, or with a disclaimer of this term. Given that applicant has made of record its own registrations for the marks DYNAMIC DATA MANAGER, TRANSIENT DATA MANAGER and DATA MANAGER, all registered without a disclaimer of MANAGER, at best the third-party registrations might be used to show that the Office's policy with respect to MANAGER marks is inconsistent. However, it appears to us that the third-party registrations are for computer software which is actually used for managing purposes, e.g., RUG MANAGER for computer software for use in inventory management applications used in the Oriental rug and carpet industry.⁸ Applicant's software, on the other hand, is used to monitor the status of rotating shafts, rather than to manage them.

For the same reason, the Examining Attorney's reliance on **In re Time Solutions Inc.**, 33 USPQ2d 1156 (TTAB 1994) is misplaced. In that case, the mark YOUR HEALTH INSURANCE MANAGER was found to be merely descriptive of software programs for personal record keeping and processing of medical records, health insurance and claims because consumers would readily understand applicant's services, described in its advertising as "software to manage your medical records and health insurance," as being software

⁸ Registration No. 2,267,889.

that manages health insurance matters. In the present case, however, there is no evidence that the monitoring of the status of rotating shifts would be referred to as managing.

For the foregoing reasons, we find that the evidence of record fails to prove that MACHINE MANAGER is merely descriptive of a diagnostic software tool to monitor the status of rotating shafts primarily for use in power plants and petro-chemical processing plants.

Decision: The refusal of registration is reversed.

R. F. Cissel

E. J. Seeherman

C. E. Walters
Administrative Trademark Judges
Trademark Trial and Appeal Board